

REMARKS

In the Official Action, the Examiner acknowledged the election of species and set forth a rejection of claims 1-4 and 6-10 under 35 U.S.C. § 102(b) as allegedly being anticipated by Lam, U.S. Patent No. 3,615,480, and claims 1-10 under 35 U.S.C. § 103(a) as allegedly being unpatentable over a combination of Lam with Nogami et al., U.S. Patent No. 5,106,724.

In response to the Official Action, the present Amendment amends claim 1 to include the subject matter of formula (I-B) from dependent claim 6 and claims 6 has accordingly been canceled without prejudice or disclaimer. It will be noted that formula (I-B) encompasses the elected species Y-1 on page 31 of the specification which is one of the stated patentably distinct species in accordance with the holding set forth in the Official Action dated July 29, 2004. Finally, new claim 27 has been added to recite a further aspect of the invention consistent with the description provided on page 34, lines 15-18.

Applicants respectfully submit that neither Lam nor Nogami et al., whether considered individually or in combination discloses or suggests the invention as defined in the claims of record. As noted above, amended claim 1 includes the nonionic aromatic ether surfactant of formula (I-B) which includes a naphthyl structure attached to an oxyethylene and/or oxypropylene chain and a defined R₂ group. Neither of the cited patents discloses or suggests this specifically claimed compound which can prevent scumming during printing and provide excellent printing durability and suppression of sludge as can be seen from the results obtained from compounds Y-1, Y-4 and Y-6 in Tables 2-4 and 5-6.

Instead, Lam has been cited for its disclosure of a polyethylene glycol alkyl phenyl ether which is chemically distinct and, as the Examiner has previously held, is a distinct species from those within the scope of formula (I-B). The failure of Lam to in any way teach the claimed invention including the defined nonionic aromatic ether surfactant of formula (I-B) along with the failure of the patent to recognize the advantages which can be attained therefrom make it clear that rejection based on Lam cannot stand.

In the Official Action, the Examiner further relied on Nogami et al. for its teaching of using a non-ionic surfactant in an amount up to 5% by weight. While applicants do not necessarily concede the propriety of relying on a single aspect of Nogami et al. in combination with Lam, even if an appropriate basis for combining the patents exists, the combination set forth in the Official Action would still not lead those of ordinary skill in the art to the invention as defined in the claims of record. Therefore, the presently-claimed invention is also patentable over the combination of Lam and Nogami et al.

Since all matters set forth in the Official Action have been fully met by the instant response, applicants respectfully request reconsideration and allowance of the present application.¹

¹ Applicants note that the Examiner has relied on certain claims of the present application as a basis of a provisional obviousness-type double patenting rejection against claims 1-10 in Application No. 10/151,868 in the Official Action dated February 28, 2005.

Should the Examiner wish to discuss any aspect of the present application,
the Examiner is invited to contact the undersigned attorney at the number provided
below.

Respectfully submitted,

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Date: June 2, 2005